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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-------------------------|------------------------|------------------|
| 09/816,944 | 03/23/2001 | Anthony Frank Menninger | 41556/04728 (RS11P074) | 6935 |
| 22428 | 7590 | 12/13/2004 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | GORT, ELAINE L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3627 | |

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/816,944 | Applicant(s) MENNINGER ET AL. | |
| | Examiner Elaine Gort | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/22/03; 10/21/02</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 9/10/01</u> . |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 6-15 in Paper No. 10/4/04 is acknowledged.

Claims 1-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10/4/04.

Double Patenting

2. Claims 6-15 are provisionally rejected under the judicially created doctrine of double patenting over the claims of list found below of copending applications. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending applications and the instant application are claiming common subject matter, such as a system for managing a supply chain utilizing a network which all participants of the supply chain have access to data and forecasting capabilities.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

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copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 6-15 are rejected because they lack patentable utility. Claims 7-18 merely claim the manipulation of data ("logic/code for" or "code for") but perform no concrete, useful or tangible result. One example of how this rejection may be overcome is by positively claiming the generation of a report or output of data.

5. Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Current office policy regarding method claims disclosed as requiring a computer but not claiming the use of a computer is to consider the claimed subject matter as non-statutory for failing to fall within the technological arts. Claims must be tied to a technological art. Tying the system to a computer would overcome this rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the sale" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the data for ordering products" in line 4. There is insufficient antecedent basis for this limitation in the claim.

In claim 7 line 6 it is unclear what is being claimed relating to "the data". It is unclear as the term "data" is used in lines 2, 3 and 4 and it is unclear if this data is all referring to the same data.

In claim 10 it is also are unclear what is being claimed regarding to "the data" as claim 6 refers to data in lines 2, 3, 4 and 6 and it is unclear if this data is all referring to the same data or two types of data.

Claim 11 recites the limitation "the sale" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the data for ordering products" in line 5. There is insufficient antecedent basis for this limitation in the claim.

In claim 11 line 7 it is unclear what is being claimed relating to "the data". It is unclear as the term "data" is used in lines 3, 4 and 5 and it is unclear if this data is all referring to the same data.

In claim 15 it is also are unclear what is being claimed regarding to "the data" as claim 6 refers to data in lines 3, 4, 5 and 7 and it is unclear if this data is all referring to the same data or two types of data.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 6-8, 10-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al. (US Patent 4,799,156).

Shavit et al discloses the claimed system and computer program product for managing a supply chain utilizing a network, comprising:

Logic/code for receiving data from a plurality of outlets of a supply chain utilizing a network (see figure 2 which shows buyers in communication with a networked supply chain system that is capable of receiving data from a entertainment media outlet of a entertainment media supply chain, for example the buyer/entertainment media outlet enters information in a RFQ to obtain a quote/bid such as for entertainment media disclosed in column 13, lines 10+), the data relating to the sale of products by outlets (column 6, line 21 discusses the system being used for “goods”);

Logic/code for generating an electronic order form based on the data for ordering products from a distributor of the supply chain (such as when the bid is converted to an order, column 13, lines 56+); and

Logic/code for allowing access to the data utilizing a network-based interface

(such as when the users of the system are allowed to obtain information related to their particular function).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. (US Patent 4,799,156) in view of Microsoft Press Computer Dictionary.

Shavit et al. discloses the claimed system but is silent regarding the use of the Internet. Microsoft Press Computer Dictionary discloses that it is known in the art to use the Internet for high-speed reliable communications (see definition of "Internet" on page 258). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Shavit et al. with Internet access as taught by Microsoft Press Computer Dictionary, in order to provide users with high-speed reliable communications.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391.

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The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Elaine Gort
Examiner
3627

December 9, 2004